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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,773	12/20/2001	Noriaki Ogishima	217573US2	6918
22850	7590	05/04/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,773

Applicant(s)

OGISHIMA, NORIAKI

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-7, 9-36, 38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 9-36, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Status of Claims

1. Claims 1, 2, 4-7, 9-36, 38 and 39 have been examined.

Response to Amendments/Arguments

2. Applicant has added new language to the claims in order to overcome the cited prior art.

Claims 1, 6, 25 and 29 are directed to an apparatus and the new language added to these claims merely further describes intended use or functional language limitations. It has been held that while features of an apparatus may be recited structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure alone (MPEP 2114; *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)). Therefore, as claims 1, 2, 4-7, 9, 10, 25-46, 38 and 39 depict structural elements in terms of functional language or "intended use" (e.g. "configured to", "connectable") they are not distinct, in terms of patentability, from the prior art.

Claims 1, 6, 11, 18, 25, and 29, each recite conditional language ("if"). According to the MPEP, however, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP 2106,

section II, C). Hence, Applicant's limitation of a process "to update a version of a program" or "to print the deciphered data" does not further limit claims 1, 6, 11, 18, 25, and 29 as in each instance the deciphered data can also be judged invalid.

Claims 2, 7, 12, and 19 recite a method, system and apparatus for requesting the enciphered data with respect to a server or apparatus. In light of the Specification (paragraphs 58, 66, 70, 76, 78 and 95), however, claims 2, 7, 12, and 19, are interpreted as request generating step or part to request data from an external apparatus wherein the data is *to be* enciphered by the transmitted enciphering key.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 6, 7, 15, 22, 25-27, 29-31, 35, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No.

6,233,684 in view of Hartrick et al., U.S. Patent No. 5,532,920 and Perlman, U.S. Patent No. 6,363,480.

As per claims 1, 2, 6, 7, 9, 15, 22, 25-27, 29-31, 33-35, 38, and 39, Stefik et al. teach an image forming apparatus comprising:

- a key sending part to an external apparatus (column 14, lines 57-61)
- deciphering part for deciphering enciphered data received from an external apparatus (column/line 14/63-15/13)
- a judging part to determine whether deciphered data is valid (i.e. user has view or play "right" and not "print" right) printing part to print valid data (figures 6, 7 and 15; column 9, lines 3-10, 28-40, and 55-60; column 18, lines 55-59)
- receiving enciphered data from an external apparatus (column/line 14/65-15/3)
- request generating at terminal equipment to request data from an external apparatus or server, wherein the data is to be enciphered by the transmitted enciphering key (column/line 14/65-15/3)
- accounting processing with respect to enciphered data (column 15, lines 54-65)

Stefik et al. teach viewing and selecting a digital work over the internet using a browser. The Examiner takes Official Notice that thumbnails and summaries in

hypertext are well-known computer programs for allowing an internet user to select internet content. Stefik et al. also teach online accounting where an external apparatus is notified of the actions performed on the user end (column 15, lines 56-65), hence it would have been obvious to one of ordinary skill to configure the system of Stefik et al. to track how user interacts with content (column 9, lines 28-62). Stefik et al. do not specifically disclose notifying an external apparatus if actions are not valid and updating software using deciphered data. Hartrick et al. teach a system of distributing content where an external apparatus is notified if an action at a user computer regarding use of said content is not valid (column/line 4/58-5/3) and updating software if deciphered data is valid and the data includes data for updating the software (figures 2, 8A and B; column 5, lines 42-63). Stefik et al. and Hartrick et al. do not specifically recite generating keys. Stefik et al. disclose a method for securing content using a combined symmetric and asymmetric system, while Hartrick et al. use public key cryptography (column 13, lines 29-67). Specifically, Stefik et al. teach enciphering content with a symmetric or secret key (e.g. DES), enciphering the secret key with a user public key and transmitting the enciphered key and content to the user. However, both Stefik et al. is silent regarding the source of the secret key (column/line 14/57-15/5). Perlman teaches a suitable system for generating secret keys. The Perlman system operates as follows: a sending party who desires to securely transmit data to a receiving party requests a secret

key from said receiving party, the receiving party generates the key and transmits the key to the sending party, who in turn enciphers the data with the key and transmits the enciphered data to the receiving party (abstract; column 3, lines 10-17; column 6, lines 4-11). Since the key is symmetric, the receiving party retains the key (copy or original) in order to decipher the enciphered data. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al., Perlman and Hartrick et al. in order to ensure limited access to content ('480, column 6, lines 13-17; '684, column 5, lines 55-59) and allow a user to only download the remaining portions of a file after a transmission interrupt instead of the whole file ('920, column 5, lines 50-63).

5. Claims 4, 5, 9, 10, 16, 17, 23, 24, 28, and 32 re rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684, Hartrick et al., U.S. Patent No. 5,532,920 and Perlman, U.S. Patent No. 6,363,480 and as applied to claims 1, 6, 15, and 22, and in further view of Chou et al., U.S. Patent No. 5,337,357.

As per claims 4, 5, 9, 10, 16, 17, 23, 24, 28, and 32, Stefik et al. teach a secure content distribution system where content is enciphered and access is determined by creator rights (figures 6, 7, and 15). Hartrick et al. teach a system of distributing content where an external apparatus is notified if an action at a user computer regarding use of said content is not valid (column/line 4/58-5/3)

and updating software if deciphered data is valid and the data includes data for updating the software (figures 2, 8A and B; column 5, lines 42-63). Perlman teaches encipher key generation and distribution where keys have limited terms (abstract; column 6, lines 13-17). However, neither Stefik et al., Hartick et al. nor Perlman, specifically disclose generating an encrypting key using a random variable unique to user device. Chou et al. teach a method for generating an encryption key that is unique to the receiving apparatus using a obvious to one of ordinary skill to combine the teachings of Stefik et al., Perlman, Hartrick et al., and Chou et al. in order to prevent a content receiving party from making content accessible to other unauthorized parties ('357, column/line 2/40-3/13).

6. Claims 11-14 and 18-21 re rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 and Hartrick et al., U.S. Patent No. 5,532,920.

As per claims 11-14 and 18-21, Stefik et al. teach an image forming apparatus comprising:

- requesting data from a server (column 14, lines 40-51)
- enciphering requested data and transmitting said enciphered data over a network (column/line 14/65-15/5)

- receiving and deciphering enciphered data with a printing function (column 15, lines 5-25)
- determining whether deciphered data is valid and printing valid deciphered data (i.e. user has view or play “right” and not “print” right) (figures 6, 7 and 15; column 9, lines 3-10, 28-40, and 55-60; column 18, lines 55-59)
- request generating at terminal equipment to request data from an external apparatus or server, wherein the data is to be enciphered by the transmitted enciphering key (column/line 14/65-15/3)

However, Stefik et al. does not specifically disclose notifying an external apparatus if actions are not valid. Hartrick et al. teach a system of distributing content where an external apparatus is notified if an action at a user computer regarding use of said content is not valid (column/line 4/58-5/3) and updating software if deciphered data is valid and the data includes data for updating the software (figures 2, 8A and B; column 5, lines 42-63). Therefore, it would have been to one of ordinary skill to combine the teachings of Stefik et al. and Hartrick et al. in order to allow a user to only download the remaining portions of a file after a transmission interrupt instead of the whole file ('920, column 5, lines 50-63).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 3600

Washington, D.C. 20231

or faxed to:

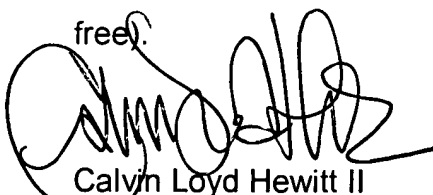
(571) 273-8300 (for formal communications intended for entry and
after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Loyd Hewitt II
Primary Examiner

May 1, 2006